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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,014	11/12/2003	Samuel C. Wang	1406-CV (P275US)	6191
31127 7590 07/11/2007 JAMES J. MURPHY THOMPSON AND KNIGHT LLP 1700 PACIFIC AVENUE SUITE 3300 DALLAS, TX 75201			EXAMINER WENDMAGEGN, GIRUMSEW	
			ART UNIT 2621	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/706,014

Applicant(s)

WANG ET AL.

Examiner

Girumsew Wendmagegn

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/3/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim19 is objected to because of the following informalities: claim19 depends on it self. Appropriate correction is required. For the purpose of compact prosecution the examiner relied on claim19 being depend on claim15

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim1-13 and 15-20** is rejected under 35 U.S.C. 102(a) as being anticipated by Kikuchi et al (Pub. No. US 2003/0147629).

Regarding claim1, Kikuchi et al (hereinafter Kikuchi) anticipates an embedded digital versatile disk recording system operable to selectively record a menu with an end-user generated background image on a digital versatile disk (see page36 paragraph 0757).

Regarding claim2, Kikuchi anticipates the recording system of claim1, wherein the background image is generated by selecting from a plurality of still background images (see figure 68 and page4 paragraph 0093).

Regarding claim3, Kikuchi anticipates the recording system of claim1, wherein the menu includes index frames and the background image (see figure 68 and page4 paragraph 0093).

Regarding claim4, Kikuchi anticipates the recording system of claim3, wherein the menu includes an index forming a button for navigating to each of a plurality of segments recorded on the digital versatile disk (see figure 68 and page4 paragraph 0093).

Regarding claim5, Kikuchi anticipates the recording system of claim1, wherein the recording system forms a portion of a stand-alone digital video disk system (see figure39-42, DVD system).

Regarding claim6, Kikuchi anticipates the recording system of claim1, wherein the background is created from data imported in a format selected from the group consisting of Joint Picture Experts Group, Graphic Interchange File, Bitmap, and Moving Pictures Experts Group formats (see page21 paragraph 0447).

Regarding claim7, Kikuchi anticipates a method of creating customized menus in an embedded digital versatile disk recording system comprising: selecting background data for generating a selected menu background (see figure 68 G1-G3); selectively converting at least one index frame from a recorded digital versatile disk into decompressed video data (see figure68 G2); composing the selected menu in decompressed space from the selected background data and the decompressed video data (paragraph 0728); compressing the composed menu; and recording the compressed composed menu onto the digital versatile disk ( paragraph 0737).

Regarding claim8, Kikuchi anticipates the method of claim7, wherein selecting background data comprises copying background data from the digital versatile disk.

Regarding claim9, Kikuchi anticipates the method of claim7, wherein selecting background data comprises importing background data from a digital data source selected from the group consisting of optical disk drives, programmed flash memory devices, and computing appliances (see paragraph 0725 background picture read from ROM).

Regarding claim10, the method of claim7, wherein selecting background data comprises selecting data for creating a still background image (see figure 68 G1-G3).

Regarding claim 11, Kikuchi anticipates the method of claim 10, wherein selecting background data comprises selecting data for creating a still background image from the group of data formats consisting of Joint Picture Experts Group, Graphic Interchange File, or Bitmap data formats (see page 21 paragraph 0447).

Regarding claim 12, Kikuchi anticipates the method of claim 7, wherein composing the selected menu comprises composing a button for navigating to a segment on the digital versatile disk from the decompressed video data (see figure 68 and page 4 paragraph 0093).

Regarding claim 13, Kikuchi anticipates the method of claim 7, wherein composing the selected menu comprises composing a menu page having a background and a plurality of buttons composed of index frames representing each of a plurality of segments recorded on the digital versatile disk (see figure 68 and page 4 paragraph 0093).

Regarding claim 15, Kikuchi anticipates a home digital versatile disk playback-recording system comprising: a digital versatile disk drive for recording and playing-back information on a digital versatile disk (see figure 40 element 32); and a processing system for recording a menu with a selectable background image on the digital versatile disk (see figure 40 element 36).

Regarding claim 16, Kikuchi anticipates the system of claim 15, wherein the processing system includes a processor and an encoder – decoder (see figure 40 elements 50 and 60) operable to: import background image data (see figure 40 element 30 background picture); selectively convert selected index frames from the digital versatile disk into decompressed video data (see figure 40 thumbnail picture data); compose the selected menu in decompressed space from the imported background image data and the decompressed video data (paragraph 0728); compress the composed menu; and record the compressed composed menu on the digital versatile disk ( paragraph 0737).

Regarding claim 17, Kikuchi anticipates the system of claim 16, further comprising a memory for storing a library of user-selectable background image data (see figure 40 element 30 ROM).

Regarding claim 18, Kikuchi anticipates the system of claim 17, wherein the memory comprises a non-volatile memory storing a preset selection of user-selectable background image data (see figure 40 element 30 ROM).

Regarding claim 19, Kikuchi anticipates the system of claim 15, further comprising a port for importing the background image data from an external source (see figure 40 element 42 and 44).

Regarding claim20, Kikuchi anticipates the system of Claim 15, further comprising an embedded drive for importing the background image data (see figure40 element 32).

**Claim1-13 and 15-20** is rejected under 35 U.S.C. 102(e) as being anticipated by Kikuchi et al (Pub. No. US 2003/0147629).

Regarding claim1, Kikuchi et al (hereinafter Kikuchi) anticipates an embedded digital versatile disk recording system operable to selectively record a menu with an end-user generated background image on a digital versatile disk (see page36 paragraph 0757).

Regarding claim2, Kikuchi anticipates the recording system of claim1, wherein the background image is generated by selecting from a plurality of still background images (see figure 68 and page4 paragraph 0093).

Regarding claim3, Kikuchi anticipates the recording system of claim1, wherein the menu includes index frames and the background image (see figure 68 and page4 paragraph 0093).

Regarding claim4, Kikuchi anticipates the recording system of claim3, wherein the menu includes an index forming a button for navigating to each of a plurality of



segments recorded on the digital versatile disk (see figure 68 and page4 paragraph 0093).

Regarding claim5, Kikuchi anticipates the recording system of claim1, wherein the recording system forms a portion of a stand-alone digital video disk system (see figure39-42, DVD system).

Regarding claim6, Kikuchi anticipates the recording system of claim1, wherein the background is created from data imported in a format selected from the group consisting of Joint Picture Experts Group, Graphic Interchange File, Bitmap, and Moving Pictures Experts Group formats (see page21 paragraph 0447).

Regarding claim7, Kikuchi anticipates a method of creating customized menus in an embedded digital versatile disk recording system comprising: selecting background data for generating a selected menu background (see figure 68 G1-G3); selectively converting at least one index frame from a recorded digital versatile disk into decompressed video data (see figure68 G2); composing the selected menu in decompressed space from the selected background data and the decompressed video data (paragraph 0728); compressing the composed menu; and recording the compressed composed menu onto the digital versatile disk ( paragraph 0737).

Regarding claim8, Kikuchi anticipates the method of claim7, wherein selecting background data comprises copying background data from the digital versatile disk.

Regarding claim9, Kikuchi anticipates the method of claim7, wherein selecting background data comprises importing background data from a digital data source selected from the group consisting of optical disk drives, programmed flash memory devices, and computing appliances (see paragraph 0725 background picture read from ROM).

Regarding claim10, the method of claim7, wherein selecting background data comprises selecting data for creating a still background image (see figure 68 G1-G3).

Regarding claim11, Kikuchi anticipates the method of claim10, wherein selecting background data comprises selecting data for creating a still background image from the group of data formats consisting of Joint Picture Experts Group, Graphic Interchange File, or Bitmap data formats (see page21 paragraph 0447).

Regarding claim12, Kikuchi anticipates the method of claim7, wherein composing the selected menu comprises composing a button for navigating to a segment on the digital versatile disk from the decompressed video data (see figure 68 and page4 paragraph 0093).

Regarding claim 13, Kikuchi anticipates the method of claim 7, wherein composing the selected menu comprises composing a menu page having a background and a plurality of buttons composed of index frames representing each of a plurality of segments recorded on the digital versatile disk (see figure 68 and paragraph 0093).

Regarding claim 15, Kikuchi anticipates a home digital versatile disk playback-recording system comprising: a digital versatile disk drive for recording and playing-back information on a digital versatile disk (see figure 40 element 32); and a processing system for recording a menu with a selectable background image on the digital versatile disk (see figure 40 element 36).

Regarding claim 16, Kikuchi anticipates the system of claim 15, wherein the processing system includes a processor and an encoder – decoder (see figure 40 elements 50 and 60) operable to: import background image data (see figure 40 element 30 background picture); selectively convert selected index frames from the digital versatile disk into decompressed video data (see figure 40 thumbnail picture data); compose the selected menu in decompressed space from the imported background image data and the decompressed video data (paragraph 0728); compress the composed menu; and record the compressed composed menu on the digital versatile disk (paragraph 0737).

Regarding claim17, Kikuchi anticipates the system of claim16, further comprising a memory for storing a library of user-selectable background image data (see figure40 element 30 ROM).

Regarding claim18, Kikuchi anticipates the system of claim17, wherein the memory comprises a non-volatile memory storing a preset selection of user-selectable background image data (see figure40 element 30 ROM).

Regarding claim19, Kikuchi anticipates the system of claim15, further comprising a port for importing the background image data from an external source (see figure40 element 42 and 44).

Regarding claim20, Kikuchi anticipates the system of Claim 15, further comprising an embedded drive for importing the background image data (see figure40 element 32).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al (Pub. No. US 2003/0147629).

Regarding claim 14, Kikuchi does not teach downloading the background data from a computer network. However it is old and well known in the art downloading images and other data from a computer network. Therefore official notice is taken.

One of ordinary skill in the art at the time the invention was made would have been motivated to download background data from a computer network in Kikuchi system because it would give the user more selection of background images.

Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to Method and apparatus for generating and selecting of title frames for insertion into recording: US 6,859,608

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, all Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thai Tran

Supervisory Patent Examiner

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